cheapen the rights of patent owners, forcing them to pay the heavy price of abandoning weighty evidence in order

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differently. The issue presented in this petition challenges this unanticipated and insupportable distinction made by the Federal Circuit majority and elaborates on the points of disagreement raised by the dissent. *See* Petition at 17-21 and 29 (reviewing the portions of the majority and dissenting opinions dealing with this issue).

Petitioners are not barred from discussing the issue – or from seeking review in this Court on the issue. If the court of appeals passes on an issue – even an issue not pressed by the parties – it is entirely proper for this Court to grant certiorari and review the issue. *See, e.g., United States v. Williams*, 112 S. Ct. 1735, 1738-41 (1992) ("traditional rule . . . precludes a grant of certiorari only when the question presented was not pressed or passed upon below"); *Virginia Bankshares, Inc. v. Sandberg*, 111 S. Ct. 2749, 2761 n.8 (1991) ("[i]t suffices for our purposes that the court below passed on the issue presented"); *Stevens v. Department of the Treasury*, 111 S. Ct. 1562, 1567 (1991) (same); *cf. Cohen v. Cowles Media Co.*, 111 S. Ct. 2513, 2517 (1991) (same with respect to issue "state supreme court actually considered and decided"). Indeed, the need for review by this Court of an issue that the parties did not expect to form a foundation for the court of appeals decision "often will be greater" than when an issue is properly pressed below because "the court [of appeals] has decided without the benefit of adversary presentation." Charles A. Wright, Arthur R. Miller & Edward H. Cooper, *Federal Practice and Procedure* § 4036 (1988 & 1993 Supp.); *cf. Williams*, 112 S. Ct. at 1739 n.2 (noting that "where a court disposes of a case on the basis of a new rule that had not been debated by the parties, our review may be appropriate to give the losing party an opportunity it would not otherwise have to challenge the rule").

Nor does the fact that Respondent filed the jury demand in the District Court change anything. Under Fed. R. Civ. P. 39(a)(1), there is no need for a party to make a redundant jury trial demand; the party may rely on the timely jury trial demand of another. *See Rosen v. Dick*, 639 F.2d 82, 91-92 (2d Cir. 1980); *Calnetics Corp. v. Volkswagen of America, Inc.*, 532 F.2d 674, 690 (9th Cir.), *cert. denied*, 429 U.S. 940 (1976); *Collins v. Government of the Virgin Islands*, 366 F.2d 279, 284 (3d Cir. 1966), *cert. denied*, 386 U.S. 958 (1967).

to exercise their right to a jury trial. *See United States v. Jackson*, 390 U.S. 570, 583 (1968).

Respondent complains that if the *Astec* adjudication had been admitted before the jury, the jury would have been required to compare the evidence in the *Cedarapids* case against the bases for Judge Hull's decision in the *Astec* case. (Resp. Br. at 9) This is *precisely* the task that the cases call for the subsequent decision-maker to undertake. *See, e.g., Stevenson*, 713 F.2d at 711 n.5 (the weight given the prior determination of validity "will vary depending on the additional prior and/or other evidence on patentability that is produced in the subsequent suits"); *Skil Corp. v. Lucerne Products, Inc.*, 684 F.2d 346, 351 (6th Cir.) (the prior adjudication of validity will be followed unless the accused infringer can show "a very palpable error in law or fact" in the prior adjudication), *cert. denied*, 459 U.S. 991 (1982); *American Photocopy Equipment Co. v. Rovico, Inc.*, 384 F.2d 813, 815-16 (7th Cir. 1967) (accused infringer in subsequent case bears the burden of demonstrating a material distinction between the subsequent case and the prior case), *cert. denied*, 390 U.S. 945 (1968); *Mercantile National Bank of Chicago v. Howmet Corp.*, 524 F.2d 1031, 1032 (7th Cir. 1975) (inquiry is limited to a consideration of whether additional facts not before the court in the prior case require a different result), *cert. denied*, 424 U.S. 957 (1976). Respondent's effort to characterize this as asking the jury to "sort through the minefield of different facts" (Resp. Br. at 9), once again, merely reflects an improper distrust of the jury system, as the dissent in the Federal Circuit recognized and condemned.

Interestingly, when it suited Respondent's purposes, Respondent asked that the jury compare the evidence presented in this case with the evidence presented to the PTO during the prosecution of the '904 and '905 Reissue Patents. *See Mendenhall v. Cedarapids, Inc.*, 5 F.3d 1557, 1563-64 (Fed. Cir. 1993) (reviewing jury instructions). Respondent does not explain why, if the jury was capable of comparing the evidence presented in this case with that presented to the PTO, that same jury should have been assumed to be incapable of comparing the evidence presented in this case with that presented to the *Astec* court.

Finally, Respondent's suggestion that giving proper effect to this enhanced presumption of validity would constrict its due process rights (Resp. Br. at 14) is without merit. The result of the successful prosecution of *every* patent, which is almost invariably accomplished without *any* involvement of the alleged infringer, is to create a presumption of validity that must later be overcome by that infringer. 35 U.S.C. § 282. If the creation of that presumption through *ex parte* proceedings does not violate the infringer's due process rights, how can the subsequent strengthening of that presumption through contested judicial proceedings constitute a violation of due process? It cannot, of course, and any such contention was rejected by this Court in *RCA* where Justice Cardozo stated that "a stranger to a patent suit does not avoid altogether the consequences of a judgment rendered in his absence." *See* 293 U.S. at 8.

In fact, nothing in this strengthened presumption precludes the alleged infringer from proffering evidence on the validity issue, or from arguing that it has *additional*

evidence not presented to the prior court in the prior adjudication. It is Respondent, not Petitioners, who urges that relevant evidence be kept from the jury – and that the validity determination be made on a record that is incomplete under the *RCA-Rovico-Stevenson* rule. Respondent had no due process right to create an incomplete or false record on the validity issue, contrary to the well-settled *RCA-Rovico-Stevenson* rule, simply because a jury trial had been demanded.

## CONCLUSION

Both a century of consistent case law and 35 U.S.C. § 282 require that evidence of the prior validity adjudication be given weight by the jury. Rule 403 cannot be employed to overrule that case law and 35 U.S.C. § 282, the statute which codifies that case law.

Petitioners respectfully request that the writ of certiorari issue and that the judgment of the United States Court of Appeals for the Federal Circuit be reversed with instructions to remand the cause to the United States District Court for the Northern District of Iowa for a new trial.

Respectfully submitted,

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